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OFFICE OF PETITIONS

In re Application of	:	
Chesser et al.	:	Decision on Petition for
Application No. 08/869,109	:	Patent Term Extension
Filed: June 4, 1997	:	
CPA Filed: March 24, 1999	:	
For: CONTROLLED HYDRATION OF	:	
STARCH IN HIGH DENSITY BRINE	:	
DISPERSION	:	

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition Under 37 CFR 1.181 to Review Determination of Patent Term Extension Pursuant to 37 CFR 1.701," which was received on September 9, 2004, requesting a patent term extension of 981 days. See 35 U.S.C. § 154(b)¹ and 37 C.F.R. § 1.701.

The petition under 37 CFR 1.181 is granted-in-part.

Petitioner notes that the Notice of Allowance dated December 1, 2003 in the above-identified application did not indicate a patent term extension. Petitioner requests 981 days of patent term extension from the period from May 12, 2000, the date that the Notice of Appeal was filed and ending on January 17, 2003, the date of the remand by the BAPI.

35 U.S.C. § 154(b) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for those delays and others in applications filed on or after May 29, 2000.


¹35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

A Notice of Appeal was filed in the above-identified application on May 12, 2000. On January 17, 2003, a panel of the Board of Patent Appeals and Interferences (BPAI) remanded the application to the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a remand by a panel of the BPAI to the Examiner, the patent to issue from the application is entitled to an extension of the patent term.² The period of delay in the above-identified application is the period beginning on May 12, 2000, the date that the Notice of Appeal was filed and ending on January 17, 2003, the date of the remand by a panel of the BPAI, which is a final decision in favor of the applicant. Three years after the earliest effective filing date of the application is June 4, 2000. Accordingly, the period of extension is required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the earliest effective filing date of the application. As a result, the period of extension is 958 days, the period from June 4, 2000 to January 17, 2003 including the beginning and end dates.

After mailing of this decision, the above-identified application will be returned to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by **958 days**.

The \$200 fee for the petition charged to petitioner's Deposit Account (02-0429) has been refunded.

Telephone inquiries with regard to this communication should be directed to the undersigned at (571) 272-7709.



Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

²Revision of Patent Term Extension and Patent Term Adjustment Provisions, 78 FR 21704, 21705 (April 22, 2004), 1282 Off. Gaz. Pat. Office Notices 100 (May 18, 2004) (final rule).